

Applic. No. 10/014,346
Amdt. dated December 19, 2003
Reply to Office action of September 24, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-5, 8-17, 20-23 and 25 remain in the application.

Claims 1, 8, 13, 15, and 25 have been amended. Claims 6 and 7 have been cancelled.

In item 1 on page 2 of the above-identified Office action, the Examiner stated that applicant is required to submit proof that the international application was copending with the U.S. national application.

In accordance with MPEP 1895, I Alfred Dassler, the undersigned practitioner in this case, state for the record that neither the international application nor the designation of the United States was withdrawn or considered to be withdrawn prior to the filing date of the U.S. national (35 U.S.C. 111(a)) application.

In item 3 on page 3 of the Office action, claims 1-17, 20-23, and 25 have been rejected as being indefinite under 35 U.S.C. § 112.

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More specifically, the Examiner has stated that there are omitted structural cooperative relationships between the holding device, the portal crane and the carrier. The claims have been amended so as to facilitate prosecution of the application. Therefore, the rejection has been overcome.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In item 5 on page 3 of the Office action, claims 1-10, 12-13, 16, 17, 20-23, and 25 have been rejected as being fully anticipated by Hirata et al. (U.S. Patent No. 6,604,624) (hereinafter "Hirata") under 35 U.S.C. § 102.

Applicants respectfully note that Hirata has a United States filing date of August 16, 2000. Therefore, applicants respectfully believe that Hirata is not available as prior art with respect to the instant application. The instant

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application is a continuation of copending international application PCT/DE00/01453, filed May 5, 2000. Pursuant to 35 U.S.C. § 363, the instant application has a filing date of May 5, 2000, because the instant application designated the United States. This date is more than three months prior to Hirata's filing date. Accordingly, Hirata is unavailable as prior art. Therefore, the Examiner is requested to withdraw the rejection over Hirata.

In item 7 on page 4 of the Office action, claims 1-17, 20-23, and 25 have been rejected as being obvious over Iwasawa (JP 63-037626) in view of Kato (U.S. Patent No. 5,161,936) under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claims 6 and 7 of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 25 call for, *inter alia*:

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a portal crane including a carrier having a rail guide and a boogie guided in the rail guide and connected to a holding device which holds a transport container.

The Iwasawa reference discloses a robot system capable of transferring a pot in an x-z plane between several fabrication units. The horizontally and vertically moveable robot operates at the same height as the fabrication units. The robot system prevents dust from being generated during the movement of an overhead mobile robot along a linear guide by placing the linear guide in a vicinity of an air supply and exhaust section. The robot M is movable in a three dimensional fashion by shifting a holding section M1, providing an arm section M2, and a lowerable robot body M3. Iwasawa does not disclose a carrier between horizontal rails.

The Kato reference discloses a crane installation having two parallel rails (3a and 3b) mounted on pillars (2a and 2b) along with traversing rails (37 and 38), which support robots (4 and 5). The Kato reference does not disclose a rail guide, boogie, holding device, nor a transport container. Furthermore, the Kato reference does not provide disclosure to provide the crane installation in a semiconductor factory.

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It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest a portal crane including a carrier having a rail guide and a boogie guided in the rail guide and connected to a holding device which holds a transport container, as recited in claims 1 and 25 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, it is applicants' position that a person of ordinary skill in the art would not combine the teachings of Iwasawa and Kato, for the reasons set forth hereinafter.

The main function of the Iwasawa reference is to provide a dust-free movement of the robot by using a linear guide along with a dust collector. The Kato reference discloses providing two robots with one robot being switched off while the other robot is in use. There is, however, no direct link between the references.

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Moreover, a person of ordinary skill in the art would not modify the installation according Iwasawa so that the robot is mountable on a carrier as disclosed in Kato. This is the case because such a modification would give rise to a non dust free movement of the robot as the movement of the robot would no longer be in a vicinity of the dust collector and the air supply and exhaust sections. Since the modification of Iwasawa as suggested by the Examiner would destroy its intended function, there is no motivation to combine the references.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems,

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Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Iwasawa to incorporate the features of Kato, and there is no teaching or suggestion in Kato to incorporate the features of Iwasawa.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5

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USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825

(1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Iwasawa or Kato or to combine Iwasawa's and Kato's teachings to arrive at the claimed present invention.

Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Iwasawa or Kato or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Since claim 1 is believed to be allowable, dependent claims 2-5, 8-17, and 20-23 are believed to be allowable as well.

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It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 25. Claims 1 and 25 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-5, 8-17, 20-23 and 25 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

12-19-'03 16:15 FROM Lerner & Greenberg

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


For Applicant(s)

Alfred K. Dassler
52,794

AKD:cgm

December 19, 2003

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101